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| 09/941,386      | 08/28/2001  | James C. Ori         | 705558US1           | 5998             |

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EXAMINER

GUTMAN, HILARY L

ART UNIT PAPER NUMBER

3612

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/941,386

Applicant(s)

Ori et al.

Examiner

Hilary Gutman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 18, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-16 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Nov 18, 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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## **DETAILED ACTION**

### ***Drawings***

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 11/18/2002 have been acknowledged and approved by the examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 6 and 7, it should be noted that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (MPEP 2113).

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*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-4, 6-8, 10-11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Vlahovic.

Vlahovic discloses a motor vehicle frame assembly having a tubular frame member 2 for absorbing energy in the event of a collision and a structural member 1 disposed partially “in” the tubular frame member, the structural member comprising: a generally tubular body having an outer perimeter complimentary to an inner perimeter of the tubular frame member, the tubular body being disposed within the tubular frame member to locally increase the movement of inertial and at least one rib (Figure 1) disposed in the tubular body. The frame assembly includes a joint which is considered a place where two parts are joined and the structural member is located in a tubular main frame at the joint. The joint is defined by the tubular frame member and a second frame member (Figure 2). The structural member is constructed of aluminum

For claims 6 and 7, it should be noted that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (MPEP 2113).

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The structural member is fixedly attached to the tubular main frame by gluing (adhesive), riveting, screwing (fasteners), welding, or the like (Column 3, lines 64-66). The ribs apparently extend the length of the tubular body. The ribs are orientated generally horizontally.

6. Claims 2 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Norlin.

Norlin discloses a motor vehicle frame assembly having a tubular frame member 13 for absorbing energy in the event of a collision and a structural member 12 disposed in the tubular frame member, the structural member comprising: a generally tubular body having an outer perimeter complimentary to an inner perimeter of the tubular frame member, the tubular body being disposed within the tubular frame member to locally increase the movement of inertial and at least one rib disposed in the tubular body. The frame assembly includes a joint, generally at 16 and 17. A joint is considered a place where two parts are joined.

The structural member is located in a tubular main frame at the joint. The ribs extend the length of the tubular body. The ribs are orientated generally horizontally. The ribs are orientated generally vertically. The ribs are oriented in an intersecting pattern.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vlahovic as applied to claim 2 above and in view of the well known prior art.

Vlahovic discloses the structural member being constructed of aluminum but lacks the structural member being constructed of steel.

The well known prior art teaches the use of steel for motor vehicle structures such as frame assemblies since this material has a high rigidity and strength (see Wycech '588 and Townsend).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the structural member of Vlahovic out of steel as taught by the well known prior art in order to provide additional rigidity and strength to the frame assembly.

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9. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vlahovic as applied to claim 8 above and in view of the well known prior art.

Vlahovic discloses the structural member being fixedly attached to the tubular main frame by gluing (adhesive), riveting, screwing (fasteners), welding, or the like (Column 3, lines 64-66).

Vlahovic lacks the structural member being fixedly attached to the tubular main frame by an interference fit or by external depressions.

However, leaves open the fact that other methods of attaching the structural member to the tubular main frame are possible. Furthermore, interference fits and external depressions of the type claimed are well known in the prior art (see Rich et al. 5,219,197 and Townsend 6,010,182) for use in attaching vehicle components together and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used either an interference fit or external depressions for attaching the structural member of Vlahovic as obvious expedients.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 4-16 have been considered but are moot in view of the new ground(s) of rejection.

11. With respect to claims 2-3, Applicant's arguments filed 11/18/2002 have been fully considered but they are not persuasive.

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Applicant states that Vlahovic does not disclose a structural member disposed in a tubular frame member. The examiner disagrees and believes that the structural member of Vlahovic is substantially or at least partially disposed "in" the tubular frame member.

Furthermore, the applicant goes on to state that Vlahovic discloses no element that could be construed to be a joint. The examiner again disagrees and believes that a joint is considered a place where two parts are joined. As seen in Figure 2 a joint is clearly shown where the members come together.

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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13. Any inquiry concerning this communication from the examiner should be directed to Hilary L. Gutman whose telephone number is (703) 305-0496.

14. Any response to this final action should be mailed to:

Box AF

Assistant Commissioner for Patents

Washington, D.C. 20231

or faxed to:


(703)305-3597, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

or:

(703)305-0285, (for informal or draft communications, please clearly label  
"PROPOSED" or "DRAFT").

hlg

December 16, 2002

  
D. GLENN DAYOAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600